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#10

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24 MAR 2000

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In re Application of
LAUK
Application No.: 08/981,924 :
PCT No.: PCT/DE96/01269 :
Int. Filing Date: 12 July 1996 :
Priority Date: 12 July 1995 :
Attorney Docket No.: P2941 WO US :
For: METHOD FOR DETERMINING THE
EFFECTIVENESS AND TOLERANCE OF A
XENOGENIC SUBSTANCE ADMINISTERED
TO AN ORGANISM :

DECISION ON
PETITION UNDER
37 CFR 1.137(a)

This decision is in response to the petition entitled "Request for Reconsideration of Decision on Renewed Petition under 37 CFR 1.137(a)" filed 27 December 1999.

BACKGROUND

On 30 March 1999, the PTO mailed a Decision on Petition dismissing applicant's petition to revive under 37 CFR 1.137(a). The Decision indicated that the applicant had not provided evidence of the date and time the papers were delivered to Federal Express and that there was no evidence provided from Federal Express as to how long it should take to deliver a package from Germany to the PTO and therefore applicant did not meet the burden of establishing that the delay was unavoidable.

On 20 May 1999, the PTO received a "RENEWED PETITION TO REVIVE UNDER 37 CFR 1.137(a)" again requesting that the abandonment be considered unavoidable and that the application be revived. The renewed petition included a Federal Express invoice indicating dispatch of a package from Paul J. Vincent in Stuttgart, Germany to the PTO on 08 January 1998 and delivery to the PTO on 13 January 1998. The renewed petition also included a letter from Federal Express indicating that the mail time for a package from Germany to the United

States is two work days.

On 12 November 1999, the PTO mailed a Decision on Renewed Petition dismissing applicant's renewed petition. The Decision indicated that there was no evidence that the Federal Express invoice provided corresponds to the 35 U.S.C. 371 application papers received by the PTO on 13 January 1998 and assigned application number 08/981,924 and that the delay is not considered unavoidable because a one day mailing or shipping delay cannot be considered an unexpected or unforeseen fault or imperfection of the delivery service and the shipment of a package on the last possible day which would ensure its timely delivery service is less than the care or diligence generally used and observed by careful persons in relation to their most important business.

On 27 December 1999, the PTO received a "Request for Reconsideration of Decision on Renewed Petition under 37 CFR 1.137(a)" again requesting that the abandonment be considered unavoidable and that the application be revived. This request for reconsideration was accompanied by:

- a list of final deadlines noted by the Law Offices of Schuster & Partner from 21 December 1997 to 15 February 1998 (Annex A);
- a Federal Express invoice received by petitioner for the applicant in connection with his counsel activities for Kohler, Schmid & Partner (Annexes B1 and B2);
- a copy of a check for the above-identified application (Annex C);
- a copy of a calendar indicating the vacation and sick days for at least some of the employees of Schuster & Partner for September-December 1997 (Annex D); and
- a copy of a similar calendar for January-May 1998 (Annex E).

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(a) must include:

- (1) The required reply;
- (2) The petition fee;
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.

Applicant has previously satisfied items (1) and (2).

As to item (3), petitioner contends that (a) the evidence accompanying the request for reconsideration proves that the Federal Express invoice provided corresponds to the 35 U.S.C. 371 application papers received by the PTO on 13 January 1998 and assigned application

number 08/981,924 and contends that (b) the delay is unavoidable for reasons discussed in the request for reconsideration.

As to (a), it is contended that the papers which were actually received by the PTO on 13 January 1998 for the above-identified application correspond to the papers sent on 08 January 1998 in the Federal Express package. On the Federal Express invoice submitted with the renewed petition on 20 May 1999, 08 January 1998 is listed as the shipping date and 13 January 1998 is listed as the date of receipt in the PTO. Petitioner contends that the Federal Express invoice received 20 May 1999 by the PTO establishes that some papers were received by the PTO on that date. Petitioner further states that no Courier Service other than Federal Express has ever been used by him in his activities before the United States Patent and Trademark Office when acting directly from Germany. Petition also contends that Federal Express issues a single invoice for multiple mailings within several days of each other and provides Annexes B1 and B2 as support for this contention. However, the arguments and evidence are not persuasive. First, while Annexes B1 and B2 show a single invoice for multiple listings from Federal Express, it is not at all clear when such lists are generated. For example, they could be generated weekly, monthly, at random intervals, or after a set number of mailings. Further, it is not clear if an invoice having multiple listings only lists mailings paid for in a particular manner, for example, by check or deposit account. Thus, it is not at all clear that the invoice submitted with the renewed petition on 20 May 1999 is evidence that this was the only mailing by petitioner around 08 January 1998. Second, the copy of the invoice received by the PTO on 20 May 1999 is incomplete. The copy is an enlarged copy and, *inter alia*, the weight of the package is missing. Also, it is not clear that there are no other entries on the page beneath the entry which was enlarged. Further, that copy of the invoice does not include a total for all packages listed as is shown in Annex B2. Third, the items listed on Annex A which were due around 12 January 1998 are not explained. Although the invoice may establish that papers were received by the PTO on 13 January 1998 at Box PCT, this does not require that the papers in that package were actually for a PCT application. Perhaps some of the items listed in Annex A were also due in the PTO around that time. The package for which the copy of the invoice was submitted 20 May 1999 may have contained papers for one of these applications. Moreover, assuming *arguendo* that a deposit date of 08 January 1998 was proven, the request for reconsideration would still be denied for the reasons set forth below regarding (b).

As to (b), petitioner states that the delay was unavoidable because of the actions of an employee, Miss Nicole Strohmenga. It is stated that petitioner worked closely with Miss Strohmenga and explained all necessary procedures. However, many elements regarding the work and training of Miss Strohmenga are not explained, e.g., the degree of supervision of her work, her experience in handling such work, examples of other work functions carried out, and checks on the work which were used to assure proper execution of assigned tasks. (Note that an adequate showing requires, where possible, a verified statement by all persons with

direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.) In one part of the petition, it is implied that no checks were used to assure execution of assigned tasks: "the calendar of deadlines which had been kept by Miss Strohmenga was not reviewed by any other persons, since Miss Strohmenga was responsible for all of her deadlines and since it was normal Office Policy that the person keeping the respective calendar must either observe the deadline or notify a colleague." However, it is later stated that on 08 January 1998 a colleague "through a routine check of the calendar of Miss Strohmenga" discovered that the deadline for nationalization of the above-identified application had not yet been observed. Thus, it is unclear whether checks were used. The failure to use checks is less than the care or diligence generally used and observed by careful persons in relation to their most important business. Moreover, in this instance, even if checks were used, the lapse in checking the calendar is less than the care or diligence generally used and observed by careful persons in relation to their most important business. The petition states that Miss Strohmenga worked one full day and one partial day between 19 December 1997 and 12 January 1998. No one in the office knew how to contact her when she was not at the Office during this time (her having moved 19 December 1999). Yet her calendar of deadlines was not reviewed until 08 January 1998. Additionally, Annex A which appears to be dated 18 December 1997 (top right hand corner), appears to show a person having the initials "Vo" as being in charge of processing the national phase application of Lauk in the U.S. The initials for Miss Strohmenga appear to be "Ni". Thus, the evidence provided seems to indicate that as late as 18 December 1997 someone other than Miss Strohmenga was responsible for processing the national stage application. Further, as noted in the previous Decision mailed 12 November 1999, a one day mailing or shipping delay cannot be considered an unexpected or unforeseen fault or imperfection of the delivery service. One day is not enough time to account for expected delays due to, e.g., snow and ice. Finally, it is noted that the declaration was not due on 12 January 1998 but only the basic national fee. Accordingly, applicant could have mailed the basic national fee in December and forwarded the declaration at a later time to avoid abandonment.

CONCLUSION

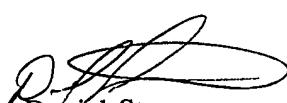
For the reasons above, the request for reconsideration of the petition under 37 CFR 1.137(a) is DISMISSED.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Alternatively, as noted in the Communication mailed by the PTO on 06 October 1998,

applicants may wish to consider filing a petition under 37 CFR 1.137(b) to revive the application as being unintentionally abandoned. The requirements for a petition under 37 CFR 1.137(b) are less stringent than those under 37 CFR 1.137(a) as the entire delay in filing the required reply must only have been "unintentional" rather than "unavoidable".

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked or the attention of the PCT Legal Office.



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